

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 4, 2005. At the time of the Office Action, Claims 1 and 4 were pending in this patent application. Claims 1 and 4 were rejected. New Claims 21-34 have been added. Thus, Claims 1, 4, and 21-34 are presently pending. Applicant respectfully requests reconsideration and favorable action in this case.

The Dodd Reference

As an initial matter, Applicant respectfully submits that the Final Office Action misconstrues the teachings of the *Dodd* reference. Thus, aspects of the *Dodd* reference are summarized below.

*Dodd* is directed to a system and method for forwarding an online gift that permits a first recipient to forward a gift to a second recipient. *See Dodd*, Abstract. In accordance with *Dodd*, a gift is selected by a user for a recipient. *See Dodd*, Column 4, lines 40-43. The recipient has three options: (i) accept the gift; (ii) exchange the gift for a substitute; or (iii) forward the gift to another recipient. *See Dodd*, Column 3, lines 30-35 and lines 57-67.

The user in *Dodd* is given two options regarding how to fulfill and deliver the gift selection. The user can select: (i) an exchangeable fulfillment option that allows the recipient to exchange the gift; or (ii) a direct order fulfillment in which the gift is sent directly to the recipient without allowing the recipient to exchange it prior to shipping it. *See Dodd*, Column 5, lines 4-9.

*Dodd* does not disclose, teach or suggest a method in which a plurality of gift sets are presented to a purchaser. Nor does *Dodd* disclose, teach or suggest that the gift sets may be customized according to a plurality of specific criteria. Nor does *Dodd* disclose, teach or suggest that at least one of the specific criteria regarding the selection may be received from the recipient of the gift set.

**Section 103(a) Rejections**

The Final Office Action rejects Claims 1 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,633,849 issued to Dodd (“*Dodd*”) in view of Official Notice. Applicant respectfully traverses these rejections for the reasons stated below.

Claim 1 is directed to a method for conducting a transaction, in which a plurality of gift sets are presented to a purchaser. Each of the gift sets include a plurality of articles, and each gift set may be customized according to a plurality of specific criteria. *Dodd* does not disclose, teach or suggest each of these limitations.

For example, *Dodd* does not disclose, teach or suggest that a plurality of gift sets are presented to a purchaser. The Final Office Action contends that “[i]t was old and well known in the art to include in gift giving the opportunity to provide gift sets” and that “it would have been obvious to a person having ordinary skill in the art to include gift sets in the selection process.” *See Final Office Action*, Page 3. Applicants respectfully disagree. Furthermore, Applicant fails to see how this is pertinent to the claimed invention. Claim 1 includes the limitation “presenting a plurality of gift sets to a purchaser, each gift set comprising a plurality of articles.” This limitation is not disclosed, taught or suggested by *Dodd* with or without the purported Official Notice of the Final Office Action. To the extent that the Examiner intends to rely upon Official Notice or any teaching that is purportedly “well known in art” to obviate this limitation, Applicant respectfully requests that the Examiner cite a reference or publication to support this proposition. In the alternative, Applicant respectfully requests that the Examiner provide a signed Affidavit establishing this fact.

Moreover, *Dodd* does not disclose, teach or suggest that the gift sets may be customized according to a plurality of specific criteria. Since the Final Office Action readily admits that *Dodd* does not disclose, teach or suggest gift sets, it is difficult to understand how *Dodd* can disclose, teach or suggest that the gift sets may be customized according to a plurality of specific criteria.

The Final Office Action contends that *Dodd* discloses that each gift set may be customized according to a plurality of specific criteria at column 10, lines 35-50. Applicant respectfully disagrees. The cited portion of *Dodd* is referring to an electronic gift certificate

that is delivered to a recipient that exchanges a gift that had been selected by a user. Thus, the recipient does not accept a gift and instead elects to exchange it for a gift certificate. The recipient is further able to designate if only one gift certificate should issue or if multiple gift certificates should issue. *See Dodd*, Column 10, lines 35-50.

Thus, even under the mischaracterization of *Dodd* set forth in the Final Office Action, the gift certificate is not a gift set that may be customized according to a plurality of specific criteria. According to *Dodd*, the gift certificate is not even the “gift” that was selected by the user. Instead, the gift certificate is an alternative that is selected by a recipient that does not accept a gift.

The Final Office Action contends that *Dodd* discloses “scheduling delivery of the selection to the recipient, if the recipient accepts the gift set” at Figure 5, item 540. *See Office Action*, page 3. Applicant respectfully disagrees and contends that this is a mischaracterization of *Dodd*. Figure 5, item 540 of *Dodd* refers to whether the “user” accepts the gift “with existing order options.” This does not refer to whether the recipient accepts the gift and does not disclose, teach or suggest “scheduling delivery of the selection to the recipient if the recipient accepts the gift” as delineated in Claim 1.

For at least the reasons discussed above with regard to Claim 1, Applicant respectfully contends that Claim 1 is patentably distinguishable from *Dodd*.

Claim 4 depends from Claim 1 and includes the additional limitation “receiving at least one of the specific criteria regarding the selection from the recipient.” The Final Office Action contends that *Dodd* discloses these limitations at column 10, lines 35-50. *See Final Office Action*, Page 3. The Final Office Action contends further that “*Dodd* permits customization of a gift by allowing the recipient to exchange the gift based on certain criteria provided by the gift giver.” *See Final Office Action*, Page 4. The Final Office Action further contends that *Dodd* “clearly teaches” the limitation receiving at least one of the specific criteria from the recipient” where the recipient is permitted to exchange or re-gift the received gift.” *See Final Office Action*, Page 4. Applicant respectfully disagrees and contends that this is a mischaracterization of *Dodd*.

As discussed above, *Dodd* allows a recipient to exchange a gift for an electronic gift certificate. *See Dodd*, column 10, lines 23-29. The recipient is also able to

designate if only one gift certificate should issue or if multiple gift certificates should issue. *See Dodd*, Column 10, lines 46-51.

Thus, according to the Final Office Action, if the recipient does not accept the gift but instead exchanges it for a gift certificate, then the recipient has provided at least one of a plurality of specific criteria regarding the gift. Applicant respectfully disagrees. Moreover, the cited portions of *Dodd* do not disclose, teach or suggest receiving at least one of a plurality of specific criteria of which a gift set may be customized, from a recipient of the gift set.

### **New Claims**

Each of new claims 21-34 depend, either directly or indirectly, from Claim 1. Thus, Applicant respectfully contends that each of new Claims 21-34 are patentably distinguishable from *Dodd* in view of the Official Notice of the Final Office Action for example, for the same reasons discussed above with regard to Claim 1.

Applicant contends further that each of new Claims 21-34 are fully supported by the specification as originally filed. For example and not by way of limitation, support for new Claims 21-23 may be found at page 8; support for new Claims 24-27 may be found at page 23; support for new Claim 28 may be found at page 27; support for new Claims 29 and 30 may be found at page 29; support for new Claims 31 and 32 may be found at page 30; and support for new Claims 33 and 34 may be found at page 16.

CONCLUSION

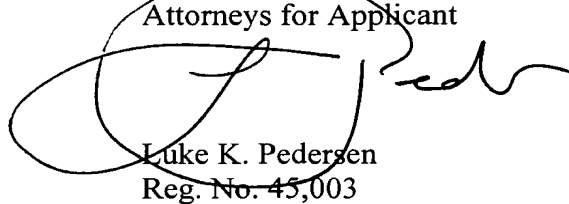
Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1, 4, and 21-34.

Attached herewith is a check in the amount of \$395.00 made payable to the "Commissioner of Patents and Trademarks" to satisfy the request for continued examination fee of 37 CFR 1.117(e). Also attached hereto is a Transmittal with Additional Claims calculated for additional new claims.

Although Applicant believes that no other fees are currently due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P. In addition, if a petition for an extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, Applicant requests that the Commissioner consider this paper to be a request for an appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call its attorney at the number listed below.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
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Date: 3/6/06

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